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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/673,987

01/08/2001

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JAMES 46.001

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06/04/2002

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EXAMINER

CLARDY, S

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 06/04/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,987

Applicant(s)

Innes

Examiner

S. Mark Clardy

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 5, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6-9, 11, 12, 14, 16, 17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, 47-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-9, 11, 12, 14, 16, 17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, 47-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 1, 2, 4, 6-9, 11, 12, 14, 16, 17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, and 47-49 are pending in this application which has been filed under 35 USC 371 as a national stage application of PCT/NZ99/00047, filed April 21, 1999. This application possesses unity of invention under 37 CFR 1.475 (MPEP 1850, 1893.03(d)). Claim 15 has been canceled. The abstract has been received.

Applicants' claims are drawn to agrochemical compositions, methods of making them, and methods of use, comprising:

- a) monoterpene¹ alcohol: a pine oil with at least 60% alcohol content
- b) a fatty acid soap: an alkali metal salt of a tall oil and/or a fatty acid,
- c) optional monocyclic monoterpene aldehydes, ketones, or other materials²,
- d) optional adjuvants and active agents³.

wherein there is sufficient fatty acid soap or foam enhancing agent to form a surface monolayer of bubbles when used.

Claims 17 and 21 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Again, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim

¹Claim 8: pinenes, terpeneols, borneols, isoborneols, eucalyptus oil, citronellol, liminol, citrus oils

²Claim 9: anethols, fenchols, limonenes, camphenes, thujols, dipentes, eugenols, phellandrenes, cavaracols

³Claim 17: surfactants, foaming agents, emulsifiers, pesticides fungicidal agents, and fertilizer

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does not clearly set forth the metes and bounds of the patent protection desired⁴. In the present instance, the claims recite the broad recitation "pesticide", and also recite "fungicide" which is the narrower statement of the range/limitation. Note that a fungicide is a pesticide.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1 and 2 are again rejected under 35 U.S.C. 102(a), (b), and (e) as being anticipated by Comparative Example 1b of Barranx et al (US 5,763,468).

Barranx et al teaches disinfectant compositions comprising at least one terpene alcohol and at least one bactericidal acidic surfactant. Comparative Example 1b comprises 20% pine oil and 20% tall oil sodium fatty acid soap. The pine oils used in the patent have a terpenic alcohol content of 88-93% (col 5, lines 26-31), which would appear to be within applicant's range of above 60%

⁴Board citations from the previous office action: Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

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or 80%. The composition of the comparative example 1b would appear to inherently possess the characteristics described in functional language at the end of claim 1, i.e., the ability to foam. (It is noted that applicant's preferred ratio of tall oil to pine oil would not allow for equal amounts of these components; see page 19, lines 10-11).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6-9, 11, 12, 14-17, 19, 21-25, 28-29, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Barranx et al and Richter (US 5,728,672).

The disinfectant compositions of Barranx et al has been discussed above.

Richter teaches pine oil (columns 2-3) cleaning compositions (Abstract) which may also contain anionic surface active agents including fatty acid (C₈₋₂₀) salts (col 9, lines 24-28).

While these patents are from non-analogous art, there is no requirement that the prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness, so long as the prior art suggests a reason or provides motivation to make the claimed invention, even where the reason or motivation is based on a something different from that discovered by applicant.

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One of ordinary skill in the art would be motivated to combine these references because they disclose the utility of combining terpene or pine oil components with soap materials in disinfectants.

Thus it would have been *prima facie* obvious to one of ordinary skill in the disinfecting composition art at the time the invention was made to have combined applicants' monoterpene alcohol (pine oil) with a fatty acid soap because the prior art teaches that these components were known to be useful in combination as disinfectant compositions. The addition of other optional components (surfactants, emulsifiers, etc.) would have been obvious to the ordinary artisan in the disinfectant art. None of applicants' pesticidal methods have been rejected over these references. As noted above, it would appear that such compositions would possess the ability to foam.

Claims 1, 2, 4, 6-9, 11, 12, 14-17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Pullen et al (US 5,753,593) and Evans et al (US 5,948,731).

Pullen et al teach the utility of terpene oils such as pine oil and various citrus oils (col 2, lines 4-13), in combination with surfactants, preferably the salts of fatty acids (col 3, lines 14-20), as aquatic herbicidal agents. Applicant asserts that Pullen does not teach the alcohol content of the pine oil as being at least 60% by weight. However, in the paragraph cited above in column 2, Pullen states:

High terpene containing natural oil as used herein means those natural oils having a terpene content of at least fifty (50%) percent. It is preferable that the high terpene natural oil contains at least ninety (90%) percent."

Thus, the pine oil component of Pullen does fall within applicant's range of at least 60%.

Evans et al teach that fatty acid salts were known herbicidal agents.

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One of ordinary skill in the art would be motivated to combine these references because they disclose the utility of fatty acid salts in herbicidal compositions.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined applicants' monoterpene alcohol (pine oil) with a fatty acid soap because the prior art teaches that these components were known to be useful in herbicidal compositions. The addition of other optional components (surfactants, emulsifiers, etc.) would have been obvious to the ordinary artisan in the herbicidal art. Again, it would appear that because of the components of the composition, foaming would be expected.

No unobvious or unexpected results are noted; no claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.



S. Mark Clardy
Primary Examiner
AU 1616

May 31, 2002